

Docket No.: 223002099600
223002099601
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent and Patent Application of:
Vincenzo SCARLATO et al.

Patent No.: 6,914,131

Art Unit: 1631

Issued: July 5, 2005

Examiner: Shubo ZHOU

Patent Ser. No.: 10/864,684 (continuation of above)

Art Unit: 1645

Filed : June 8, 2004

Examiner: P. Baskar

For: NEISSERIAL ANTIGENS

**VERIFIED STATEMENT IN SUPPORT OF PETITION FOR RETROACTIVE FOREIGN
FILING LICENSE PURSUANT TO 37 C.F.R. §5.25**

I, Cameron J. MARSHALL, declare as follows:

1. I am submitting this statement in support of the Petition for Retroactive Foreign Filing License for:

- GB App. No. 9723516.2, filed Nov. 6, 1997;
- GB App. No. 9724190.5, filed Nov. 14, 1997;
- GB App. No. 9724386.9, filed Nov. 18, 1997;
- GB App. No. 9725158.1, filed Nov. 27, 1997;
- GB App. No. 9726147.3, filed Dec. 10, 1997;
- GB App. No. 9800759.4, filed Jan. 14, 1998;
- GB App. No. 9819016.8, filed Sept. 1, 1998; and
- PCT App. No. PCT/IB98/001665, filed Oct. 9, 1998 (collectively, the “**GB Priority and PCT Applications**”).

In addition, to the extent that the foreign filing license granted for the subject matter of U.S. Ser. No. 09/303,518 granted June 9, 1999 is ineffective for the following later filed foreign patent applications and patents, this statement additionally in support of the Petition for Retroactive Foreign Filing License for:

- BR App. No. PI9813930-4, filed May 4, 2000;
- CA App. No. 2308606, filed May 4, 2000;
- CN Pat. No. CN1263854, filed June 30, 2000;
- EP App. No. 98946675.0 (issued as EP1029052), filed April 28, 2000 (together with national patents issuing therefrom);
- HK App. No. 00105869.7, filed Sept. 19, 2000;
- JP App. No. 2000-520572, filed May 2, 2000;
- MX App. No. PA/a/00/004363, filed May 4, 2000;
- RU App. No. 2000114245 (issued as RU Pat. No. RU223291), filed June 5, 2000;
and
- SG App. No. SG72388, filed April 18, 2000 (collectively, the “**National Phase Foreign Patent Applications**”).
- BR Div. No. PI9816251-9, filed July 31, 2007;
- CN Div. No. 200510113395.7, filed Oct. 17, 2005;
- EP Div. No. 07075379.3 (published as EP1900818), filed May 21, 2007;
- CA Div. No. 2,671,261, filed May 14, 2009;
- HK App. No. 01103903.9 (issued as HK Pat. No. 1033337), filed June 6, 2001;
- JP Div. No. 2005-290551, filed Oct. 3, 2005;
- MX Div. No. MX/a/2009/000817, filed Jan. 21, 2009; and
- RU Div. No. 2004100847, filed Jan. 8, 2004 (collectively, the “**Foreign Divisional Patent Applications**”)

2. Huw Hallybone and I, both European patent attorneys at Carpmaels & Ransford, have frequently been retained to prepare and file priority patent applications based upon developments

made by Chiron SpA (predecessor of Novartis Vaccines and Diagnostics, Srl.), at its Siena, Italy research facility.

3. The information upon which the above patent and patent application were based was provided to Huw Hallybone and me by researchers from Chiron SpA facility in Siena, Italy. The inventors with whom we had interacted regarding the preparation of the seven GB priority applications, Rino Rappuoli, Vega Masignani, and Vincenzo Scarlato, were all Italian citizens living in Italy and working at Chiron SpA's facility in Siena, Italy. I had no knowledge of, or reason to believe that, any of the work upon which the above patent and patent application were based was performed in the United States when my firm prepared and filed foreign patent applications also based upon such work including the seven GB priority applications on Nov. 6, 1997, Nov. 14, 1997, Nov. 18, 1997, Nov. 27, 1997, Dec. 10, 1997, Jan. 14, 1998, and Sept. 1, 1998, respectively, or the PCT patent application filed on Oct. 9, 1998, on behalf of Chiron SpA. Furthermore, I had no knowledge of, or reason to believe that, any of the work upon which the above patent and patent application were based was performed in the United States when my firm prepared and filed the two EP applications on April 28, 2000 and May 21, 2007, respectively on behalf of Chiron SpA (or Novartis Vaccines and Diagnostics Srl as successor-in-interest to Chiron SpA). Thus, the filing of the foregoing foreign patent applications without obtaining a foreign filing license from the USPTO was through error and without intent to deceive.

4. I was not aware that a foreign filing license might be required for the United States for the filing of any of the above foreign patent applications or validation of any of the patents discussed in paragraph 3 until May 6, 2009, when interviewing one of the inventors, Vega Masignani, with US Patent Attorney Otis Littlefield regarding work performed by Vega relating to U.S. Ser. No. 11/212,443. Upon hearing that Vega Masignani had performed certain of her work in Emeryville, CA, I recognized that a foreign filing license may have been required. Immediately after the interview, I raised the issue the possible need for a foreign filing license with Otis Littlefield.

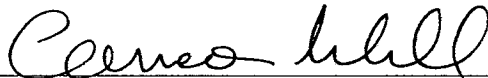
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5. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under § 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the patent and the patent application or any patent issued thereon.

23 Oct 09
Date


Name: Cameron J. MARSHALL